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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,825

Applicant(s)

DUBEY ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 21-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7, 11-14 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 5, 8-10, 15 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on May 25, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Applicant's election without traverse of Group I (claims 1-20) in the reply filed on October 8, 2004 is acknowledged.

2. Claim 7 is objected to because of the following informalities: the claim ends in a semicolon instead of a period. Appropriate correction is required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 6, 7, 12-14, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Widman et al. (U.S. Pat. No. 5,820,895).

Widman discloses a contact lens station for use with a contact lens mold assembly. In the embodiment depicted in

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figure 4, the mold assembly (12) comprises a first mold half (16) and a second mold half (14) for forming a contact lens (18) therebetween. The second mold half has a molding surface facing the first mold half for cooperation therewith to mold the lens (18) and a concave non-molding surface on a side of the second mold half opposite the molding surface (see fig. 4). The contact lens station further comprises a carrier (10) for fixing the position of the first mold half relative to the second mold half. An engaging member (50) is also provided having a convex engaging surface (52) for engaging the non-molding surface of the second mold half (see fig. 4). The contact lens station is further provided with a drive mechanism (in the form of spring 54) operative associated with the engaging member which acts drive the engaging surface against the non-molding surface of the second mold half (cl. 7, ll. 2-4 and ll. 43-46), and therefore acts to drive the mold halves together. The engaging member thereby functions as a "reciprocating piston" acted upon by the drive mechanism spring.

Widman further discloses the carrier to comprise a plurality of indentations, with the indentations configured to hold the contact lens mold assembly (see fig. 1).

Claims 1 and 12 of the instant application recite that the non-molding surface of the second mold half has a central area,

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and that the engaging surface of the engaging member is configured for centralized engagement of the central area. Claims 3 and 14 further recite that the central area of the second mold half comprises about 30% of the molding area of the second mold half, and that the central area is centered around the geometric center of the second mold half. These limitations require in effect require that the engaging member the central area of about 30 % of the molding area of the mold half, but do not limit the engaging surface from contacting more than just this central area as the claims use open-ended "comprising" terminology and do not specifically limit the engagement of the engaging surface. As shown in fig. 4, Widman's engaging member contacts the majority of the non-molding surface of the second mold half, including the central area of the non-molding surface. Widman therefore anticipates the limitations of claims 1 and 3 which merely require the non-molding surface to comprise a specific central area which is engaged with the engaging surface of the engaging member. In other words, even though Widman contacts majority of the non-molding surface, it still contacts at least 30 % of the central molding area of the second half (as the central area is defined in claim 3).

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5. Claims 1, 3, 4, 11-14, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Gartley et al. (U.S. Pat. No. 6,248,266).

Gartley discloses a contact lens molding apparatus. The apparatus, as shown in the embodiment depicted in figure 3, comprises a first mold half (21) and a second mold half (22) for forming a contact lens therebetween. The second mold half has a molding surface (24) facing the first mold half for cooperation therewith to mold the lens (see fig. 3). The second mold half also has a concave non-molding surface (28) on a side of the second mold half opposite the molding surface. The apparatus further comprises a carrier (35) for fixing the position of the first mold half relative to the second mold half. An engaging member (36) having a convex engaging surface is provided for engaging the non-molding surface of the second mold half, with the engage configured for centralized engagement of the central area of the non-molding surface (see fig. 3). Gartley notes that the apparatus brings the engaging member and the carrier into contact with the mold assemblies to start the molding operation (cl. 4, ll. 12-22), and thus the apparatus must a drive mechanism operative associated with the engaging member for driving the mold halves together which keeps the mold halves aligned during operation.

Gartley further discloses the first mold half to be a front curve mold half and the second mold half to be a back curve mold half (see fig. 3).

The engaging surface disclosed by Gartley contacts a central area of the non-molding surface of the second mold half which is at least 30 % of the molding area of the mold half (see fig. 3). As noted above in the rejection in view of Widman, claims 1, 3, 12, and 14 do not limit the engaging surface from contacting more than just this central area. Gartley therefore anticipates the contact limitations of these claims.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widman in view of Applicants' admitted prior art.

Widman discloses the contact lens molding apparatus as described above. Widman does not disclose registration apertures and pin for alignment of the engaging member and the carrier member. However, at p. 4, ll. 10-16 of the

specification of the instant application, it is noted that prior art systems have been provided with registration apertures in the carrier and corresponding registration pins associated with engaged members in order to precisely align the mold structures. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the apparatus disclosed by Widman to further comprise registration apertures associated with the carrier and registration pins associated with the engaging member because this would allow for alignment of the mold structures as suggested by Applicants' admitted prior art.

10. Claims 5, 8-10, 15 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a contact lens station with a contact lens molding assembly as defined in claims 5, 8, 10, 15, or 20. The closest prior art disclosed by Widman and Gartley is described above. Neither Widman nor

Gartley teach or suggest a light path extending through the engaging surface and second mold half, and the engaging member configured to transmit radiation or light as defined in claims 5 and 15. Widman and Gartley also do not teach or suggest the carrier to comprise a disc, with the disc configured to engage the first mold half in a ring centered around the geometric center of the first mold as defined in claim 8. Widman and Gartley further do not teach or suggest the engaging member to comprise channels as defined in claims 10 and 20.

12. The following reference cited but not relied upon are deemed pertinent to the instant application:

Bourset et al. (U.S. Pat. No. 4,211,384) discloses a molding assembly for casting soft contact lenses.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech, can be

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reached at (571) 272-1137. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


10-25-04
Donald Heckenberg
A.U. 1722